

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 8 can not be the basis for another multiple dependent claim 9. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "said compound catalyst" in line 6, there is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP Publication No 2003-0800077.

With respect to Claims 1, 2 and 3, Corp et al teaches "... sintering inhibitor (3) is an ultra-fine particle with particle diameter **below 50nm**" (see claim 13, line 1-2) and "...primary particle diameter is **100 nm or less**" (see detailed description, pg 3, line 49-50). Corp et al teaches "... **a surface layer 2** consisting one or more kinds of noble metals or noble metal oxides..." (See solution below abstract, line 4). It states that fine particles are coated by ultra-fine particles. Corp et al. teaches "...Pt which is the surface coated layer 2 functions as a **catalyst**..." (See Detailed Description, pg 6, line 25-26).

Corp doesn't expressly state the diameters of the fine particles and ultra-fine particles as required. However, where the claimed and prior art product(s) are identical or substantially identical, or are produced by identical or substantially identical process(es) the burden of proof is on applicant to establish that the prior art product(s) do not necessarily or inherently possess the characteristics of the instantly claimed product(s), see In re Best, 195 USPQ 430.

With respect to Claims 4,5,6 and 7, Corp et al teaches a discontinuous spread of ultra-fine particles (Figure 1 and 3).

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With respect to claim 8, Corp et al. teaches "...Pt which is the surface coated layer 2 functions as a **catalyst**..." (See Detailed Description, pg 6, line 25-26)

With respect to claim 9, Corp et al. teaches "The catalyst particle...metallic oxide consists of simple substance chosen from oxides and those derivatives of Ce, Zr, aluminum, **Ti**, Si, Mg, W and Sr...." (See Claims, pg 1, line 8-9)

With respect to claim 10, Corp et al teaches "This invention related to the catalyst particle of nanometer order especially **about the catalyst particle used for the object for fuel cells.**" (See Detailed Description, pg 1 line 3-5 of Corp et al.)

It is noted that claims 1-10 are product-by-process claims and are not limited to the manipulations of the recited steps, only the structure implied by the steps

"[E]ven though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (MPEP 2111.03)

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRITESH DARJI whose telephone number is (571)270-5855. The examiner can normally be reached on Monday to Thursday 8:00AM EST to 6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on 571-272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PD

/Vickie Kim/  
Supervisory Patent Examiner, Art Unit 4181

